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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/790,678 | 03/03/2004 | Matthew Rubin Lerner | 5486-0128PUS3 | 2303 |
| 67321 7590 10/17/2007 BIRCH, STEWART, KOLASCH & BIRCH, LLP 8110 GATEHOUSE ROAD SUITE 100 EAST FALLS CHURCH, VA 22040-0747 | | | EXAMINER VAUGHN, GREGORY J | |
| | | | ART UNIT 2178 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/790,678

Applicant(s)

LERNER ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7,8,10,11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7,8,10,11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Action Background

1. This action is responsive to the amendment filed 8/2/2007.
2. Applicant has amended claims 1, 2, 4, 7, 8 and 10, and added new claims 13 and 14. Claims 3, 6, 9 and 12 were previously canceled.
3. Claims 1, 2, 4, 5, 7, 8, 10, 11, 13 and 14 are pending in the case, claims 1 and 7 are independent claims.
4. Examiner's rejection of claims 1 and 7, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 4/3/2007) is withdrawn in view of the amended claims.
5. Examiner's rejection of claims 1, 2, 4, 5, 7, 8, 10 and 11, made under 35 USC 102, as being anticipated by Golovchinsky et al., US Patent 6,389,435 as recited in the previous office action (dated 4/3/2007) are withdrawn in view of the amended claims, however, new grounds of rejection are made, as described below.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

7. Claims 1, 2, 4, 7, 8, 10, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. US Patent 6,956,593, filed 9/15/1999, patented 10/18/2005 (hereinafter Gupta). Note: the figures published with Gupta are hard to read, so the examiner has provided a better set of figures gleamed from the Gupta application file.
8. **Regarding independent claim 1**, Gupta discloses web-based documents with corresponding annotation data. Gupta is directed toward annotating multimedia documents, where a multimedia document is "*multimedia data (e.g., video, audio, text, and/or animation data)*" (column 1, lines 32-33), where the multimedia content is embodied as a web page (column 4, line14). Gupta discloses annotating the documents, where the annotation corresponds to the document. Gupta recites: "*Multimedia presentations may*

also include "annotations" relating to the multimedia presentation. An annotation is data (e.g., audio, text, video, etc.) that corresponds to a multimedia presentation" (column 1, lines 62-64). Gupta discloses a plurality of web pages in Figure 1 at reference sign 12 (shown as "*Web Page Server*"). Gupta discloses in Figure 4 at reference sign 200, annotation data that corresponds to a particular web page (shown as "*Media Content Identifier*").

Gupta discloses a searchable annotation database in Figure 1 at reference signs 17 and 18. Gupta discloses an annotation database record in Figure 4 at reference sign 180, said annotation database record for holding values for the various attributes shown.

Gupta discloses searching the values of the annotation database according to a search criteria in Figure 12. Figure 12 is directed toward a "*Query Annotation*" dialog box, where various search criteria are available. Gupta discloses obtaining a search result that is a set of annotated documents that is a subset of the plurality of annotated documents in Figure 15 (see also Column 17, line 66 to column 18, line 2). Gupta discloses displaying a thumbnail image for one of the annotated documents from the subset in Figure 22 at reference sign 626.

9. **Regarding dependent claim 2**, Gupta discloses the search attributes including a time and date of the annotation – see the "*Query Annotation*" dialog box shown in Figure 12, where the time and date search attributes are shown at reference signs 382 and 384.

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10. **Regarding dependent claim 4**, Gupta discloses the search attributes including a website – see the “*Query Annotation*” dialog box shown in Figure 12, where the website search attributes are shown at reference sign 372.
11. **Regarding dependent claim 13**, Gupta discloses the search attributes as being entered by a user in Figure 12. The “*Query Annotation*” dialog box shown in Figure 12 includes user selectable attributes to define the query execution.
12. **Regarding claims 7, 8, 10 and 14**, the claims are directed toward a computer readable media for the method of claims 1, 2, 4 and 13, respectively, and are rejected with the same rationale.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

14. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta.

15. **Regarding dependent claim 5**, Gupta discloses searching annotated documents to obtain a subset of annotated documents, and displaying a thumbnail image of the document, as described above. Gupta discloses the obtained set of annotated documents includes at least two documents in Figure 15 (shown as a list of documents that satisfied the search query). Gupta fails to disclose displaying a thumbnail image for each of the documents in the search result list. However, Gupta discloses a user interface that displays multiply windows of information in Figure 22, where the information provided is a media portion, an annotation content portion, an annotation identifier portion, an annotation preview portion and a command bar. See also Figure 18, where a search result list is shown, and a control is laid on top of the list which provides a mechanism to access the annotation document (shown as "Play"). These kind of interfaces are well known, such that a system user would be able to "play" multiple annotated documents at a single time

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to use the annotation control system of Gupta to view multiple annotation documents simultaneously.

16. **Regarding claim 11**, the claim is directed toward computer readable media for the method of claim 5, and is rejected with the same rationale.

Response to Arguments

17. Applicant's arguments with respect to claims 1, 2, 4, 5, 7, 8, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection, as described above.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone

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number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
Patent Examiner
October 10, 2007


STEPHEN HONG
SUPERVISORY PATENT EXAMINER